Serial No.   09/536,969   )
) Board of Patent
                                                  Appeals
Filed: March 28, 2000   )   and Interferences
)
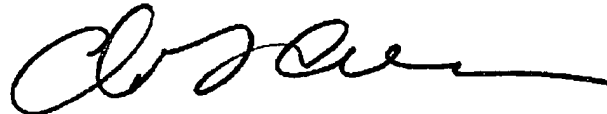Title: Systems and Methods for Modifying   )
          Broadcast Programming   )

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

FAX TRANSMISSION COVER SHEET

        The attached APPELLANTS' BRIEF (19 pages) and *REDIT CAO OF FORM*,
CLAIMS APPENDIX (4 pages) are being transmitted to the
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2004.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of   )
)
Applicants: James D. Logan et al.   )
)
Serial No.   09/536,969   )
) Board of Patent Appeals
Filed: March 28, 2000   )   and Interferences
)
Title: Systems and Methods for Modifying   )
        Broadcast Programming   )

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

APPELLANTS' BRIEF

Real party in interest

The real party in interest is Gotuit Media Corp., a Delaware corporation having its principal place of business at 300 Brickstone Square, Andover, Massachusetts, the sole owner of the present application.

Related appeals and interferences

None.

Status of claims

Claims 1-20 are pending. Claims 1-10 and 13-20 have been finally rejected and are appealed. Claims 11-12 are objected to.

Status of amendments

No amendments were filed subsequent to final rejection.

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Summary of claimed subject matter

Concise explanation of the subject matter
defined in independent claims 1 and 13

Independent claim1 defines a method for selectively reproducing locally stored programming signals comprising a combination of steps for performing the following functions:

(a) storing a first set of separate programming segments at a client location;

(b) deriving identification data from each stored segment;

(c) transmitting the identification data to a remote processing location;

(d) at the remote location, comparing the identification data with a database containing identification information and content descriptions for each of a second set of programming segments to identify common segments found in both sets;

(e) transmitting selected content descriptions which describe the identified common segments from the remote location to the client location; and

(f) presenting the selected content descriptions to a user at the client location to facilitate the selective processing of the common segments.

Independent claim 13 defines a method for selectively reproducing broadcast programming segments which comprises a combination of steps for performing the following functions:

(a) receiving a broadcast signal and continually storing the received broadcast signal in local storage as it is received;

(b) extracting brief segments from the content of the broadcast signal and transmitting those brief segments to a remote processing location;

(c) at the remote location, comparing the brief segments received with a library of previously recorded programs to identify particular programs which contain segments that match the received segments; and

(d) transmitting program guide data describing the identified particular programs to the client location.

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Correspondence between method step recitations and
The corresponding acts described in the specification and drawings

Independent claims 1 and 13, and those additional dependent claims which recite further

subject matter not disclosed or suggested by the cited references, are set forth below. In each

claim, each element that is expressed as a step for performing a specified function is

accompanied by a citation to representative portions of applicants' specification and drawings

that describe the corresponding structure or acts. These citations appear in italics within the

brackets following each recitation. These citations, as well as citations to applicants' disclosure

appearing elsewhere in this brief, identify representative portions of the application, and should

not be interpreted to suggest that there are no other passages in the application that describe

structure or acts that correspond to a given claimed step.

    1.   A method for selectively reproducing locally stored programming
signals comprising, in combination, the steps of:

    storing a first set of separate programming segments at a client location,
[Pg. 13, lines 12-27; Pg. 19, line 26 to Pg. 20, line 21; Pg. 23, lines 5-7 and 22-
28; Figs. 2 and 4 at 42; Pg. 24, lines 12-14; and Fig. 5 at 103 and 107]

    at said client location, employing processing means to derive identification
data from each of said first set of separate programming segments, *[Pg. 20, lines*
16-21; Fig. 4 at 84; Pg. 23, lines 7-9; Pg. 24, lines 1-7; and Fig. 5 at 109]

    transmitting said identification data from said client location to a remote
processing location, *[Pg. 12, lines 7-16; Pg. 20, lines 3-10, 16-29; Fig. 4 at 22A*
and 22B; Pg. 23, lines 7-9; Pg. 24, lines 12-27; and Figs. 5 and 6, arrow from
109 to 111]

    at said remote processing location, comparing said identification data with
a database containing identification information and associated content
descriptions for each of a second set of programming segments to identify
common program segments found in both said first and said second set of
programming segments, [Pg. 20, line 5 to Pg. 22, line 9; Fig. 4 at 90; Pg. 23, lines
10-18; pg. 24, lines 1-27; and Fig. 5 at 111 and 113]

    transmitting from said remote processing location to said client location
selected ones of content descriptions stored in said database which describe said
common program segments *[Pg. 12, lines 7-16; Pg. 20, lines 5-9; Pg. 22 line 6 to*
Pg. 22, line 29; Fig. 4 at 22A and 22B; Pg. 23, lines 14-21; and Fig. 5, arrow
from 113 to 115], and

    at said client location, presenting said selected content descriptions to a
user to facilitate the selective processing of said common program segments. *[Pg.*

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7, lines 20-24; Pg. 16, line 25 to Pg. 17, line 2; Fig. 4 at 54; Pg. 21, lines 20 to Pg. 22, line 29; Pg. 23, lines 12-21; Pg. 24, lines 14; and Fig. 5 at 121].

4.   The method set forth in claim 1 wherein said step of storing said first set of separate programming segments comprises receiving and recording broadcasted programming signals. [Pg. 13, lines 13-27; Figs. 2 and 4 at 14, 42, 50 and 52; and Pg. 23, lines 5-7 and 22-28]

5.   The method set forth in claim 4 wherein said identification data contained in said database are derived from said broadcasted programming signals received at said remote processing location concurrently with the reception and recording of said broadcast programming signals at said client location, [Pg. 20, lines 3-7 and 16-29; Fig. 4 at 42 and 84; Pg. 24, line 18-23; and Figs. 5 and 6 at 103 and 109] and said content descriptions transmitted to said client location from said remote processing location are used at said client location to facilitate the selective time-shifted reproduction of said broadcast programming signals [Pg. 4, lines 1-2; Pg. 22, lines 26-29; and Pg. 23, lines 18-21.]

6.   The method as set forth in 1 wherein said content descriptions transmitted from said remote processing location to said client location include information specifying the beginning and ending time of each of said common program segments. [Pg. 15, lines 1-9, and Pg. 22, lines 17-30]

7.   The method as set forth in claim 1 further including the steps of transmitting one or more selected ones of said common program segments from said client location to said remote processing location, and storing said selected common program segments at said remote processing location for subsequent retrieval. [Pg. 25, lines 3-11, and Fig. 6 at 123]

8.   The method as set forth in claim 1 further including the steps performed at said remote processing location comprising:

maintaining a stored library containing said second set of programming segments at said remote processing location, [Pg. 25, lines 3-11, and Fig. 6 at 125]

accepting a retrieval request from said client location specifying one or more particular ones of said common program segments, and [Pg. 25, lines 8-29, and Fig. 6 at 127]

responding to said request by transmitting to said client location the content of said one or more particular ones of said common program segments. [Pg. 25, lines 8-29];

9.   The method set forth in claim 8 further comprising the steps of uploading a copy of a program segment stored locally at said client location to said remote processing location and storing the uploaded copy in said stored

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library for later retrieval from said remote processing location. *[Pg. 25, lines 3-11, and Fig. 6 at 123]*

10.   The method set forth in claim 8 further including the steps of posting an entry in an accounting file upon the transmittal of said identification data to said remote processing location, subsequently transmitting a playback request identifying said client location and identifying a requested program segment, and authorizing the transmittal of said requested program segment if said accounting file contains data indicating that identification data for said requested program segment was previously transmitted from said client location. *[Pg. 25, lines 17-29, and Fig. 6 at 128 and 129]*

13. A method for selectively reproducing previously broadcast programming segments comprising, in combination, the steps of:

employing a first broadcast receiver at a client location for capturing a broadcast signal, *[Pg. 9, line 6 to Pg. 10, line 12; Figs. 2 and 4 at 14; Pg. 23, line 5-7 and 22-28, and Figs. 5 and 6 at 103]*

recording said broadcast signal in a local storage unit in a substantially continuous manner as said signal is received at said client location; *[Pg. 13, lines 12-27; Pg. 19, line 26 to Pg. 20, line 21; Fig. 4 at 42; Pg. 23, line 5-7 and 22-28, and Figs. 5 and 6 at 107;*

processing said broadcast signal at said client location to extract brief segments from the content of said broadcast signal, *[Pg. 20, lines 16-21; Fig. 4 at 84; Pg. 23, lines 7-9, and Fig. 5 at 109]*

utilizing a communications channel to transmit said brief segments from said client location to a remote processing location; *[Pg. 12, lines 7-16; Pg. 20, lines 3-10, 16-29; Fig. 4 at 22A and 22B; Pg. 23, lines 7-9; Pg. 24, lines 12-27, and Figs. 5 and 6, arrow from 109 to 111]*

comparing said segments received from said client location with a library of previously recorded programs to identify particular programs which contain segments matching the segments received from said client location, and *[Pg. 20, line 5 to Pg. 22, line 9; Fig. 4 at 90; Pg. 23, lines 10-18; pg. 24, lines 1-27, and Fig. 5 at 111 and 113]*

transmitting program guide data describing said particular programs to said client location from said remote programming location. *[Pg. 16, line 25 to Pg. 17, line 2; Fig. 4 at 22A and 22B; Pg. 21, lines 20 to Pg. 22, line 29; Pg. 23, lines 12-21; Pg. 24, lines 14, and Fig. 5, arrow from 113 to 115].*

14.   The method as set forth in claim 13 further including the steps of displaying said program guide data for use at said client station to facilitate the selection and reproduction of desired ones of said particular programs. *[Pg. 7, lines 20-24; Pg. 24, lines 14-19, and Figs 5 and 6 at 115 and 121]*

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18. The method as set forth in claim 13 further including steps, at said client location, of processing said program guide data to display a listing of the available programs in said local storage unit, and selectively processing said available programs in response to commands from a user. *[Pg. 24, lines 14-27, and Figs. 5 and 6 at 115 and 121]*

Grounds of rejection to be reviewed on appeal

Claims 1-10 and 13-20 were rejected as being directed to subject matter deemed to be obvious in view of U.S. Patent 5,572,442 issued to Schulhuf et al. (hereinafter "Schulhuf") when considered in view of U.S. Patent 6,026,446 issued to Ostrover et al. (hereinafter "Ostrover"). The specific grounds for these rejections for which review is requested are:

Ground 1: The Examiner contends in Sections 6-7, at pages 2-4, of the final rejection that Schulhuf discloses the invention substantially as claimed in independent claims 1 and 13 and in dependent claim 7 with the exception that "Schulhuf does not specifically disclose common program segments found in both said first and said second set of programming segments."

Ground 2: The Examiner contends in Section 7, at page 3-4, of the final rejection that Ostrover discloses common program segments found in both said first and said second set of program segments, and that it would have been obvious to one of ordinary skill in the art to modify Schulhuf so that it too stored a mirrored copy of its data as taught by Ostrover.

Ground 3: The Examiner contends in Section 11 at page 4 of the final rejection that the additional subject matter recited in dependent claim 5 is disclosed by Schulhuf at col. 9, line 65 to col. 10, line 64.

Ground 4: The Examiner contends in Section 12 at page 4, and again in Section 20 at page 6, that the subject matter recited in dependent claims 6 and 15 is disclosed by Schulhuf at col. 6, lines 19-23.

Ground 5: The Examiner contends in Section 14 at page 5 of the final rejection that the subject matter recited in dependent claim 9 is disclosed by Schulhuf at col. 5, lines 9-12 and 52-53; col. 6, lines 31-39; and at col. 9, line 65 to col. 10, line 4.

Ground 6: The Examiner contends in Section 15 at page 5 of the final rejection that the subject matter recited in dependent claim 10 is disclosed by Schulhuf at col. 10, lines 52-65.

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Ground 7: The Examiner contends in Section 16 at page 5 of the final rejection that the subject matter recited in dependent claims 14 and 18 is disclosed by Schulhuf at col. 5, lines 5-8.

Argument

The applicable law

All of the appealed claims are method claims directed to a combination of elements expressed as steps for performing specified functions without the recital of structure, material, or acts in support thereof. By statute, 35 U.S.C. §112, sixth paragraph, "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." *In re Donaldson Company, Inc.* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir 1994).

In the preceding section of this Brief entitled "Summary of claimed subject matter," applicants have specified, for each element of each claim, those portions of applicants' specification and drawings which describe corresponding structures and acts. As detailed below, Schulhuf does not teach or suggest an equivalent to many of these corresponding structures and acts as disclosed in this application. Schulhuf's system does not do perform many of the functions recited in claims, does not do the same thing as applicants' disclosed system, does not work in the same way as applicants' disclosed system, and does not achieve the same result as applicants' disclosed system. In detailing the many differences between Schulhuf's system and the individual elements of applicants' invention as claimed in the discussion that follows, it will be shown, over and over again, that the cited portions of Schulhuf's system are materially different from and are in no sense the equivalent of applicants' invention as claimed.

Each of the grounds enumerated above are discussed individually below:

Ground 1, Claim 1

The Examiner found, in Section 6 of the final rejection, that Schulhuf discloses the invention substantially as claimed in claim 1 (with one exception conceded by the Examiner). That finding is in error because claim 1 recites several method steps that specify functions that are not taught by the passages of Schulhuf cited by the Examiner. These important differences between the subject matter set forth in claim 1 and the system described in Schulhuf are

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separately discussed below, step by step. For each step, the lack of equivalence between the corresponding acts disclosed by applicants and the functions and structures taught by Schulhuf will be identified.

Claim 1, step 1: Claim 1 recites the step of "*storing a first set of separate programming segments at a client location.*" In applicants system as disclosed, broadcast programming segments are captured by a broadcast receiver [Fig. 5 at 103] and recorded in a local storage device [Fig.5 at 107]. For example, applicants' system might continuously record the programming content from several hours of a music broadcast from a local music radio station and the individual songs within that recorded content would correspond to "a first set of separate programming segments" recorded at the client location.

The Examiner correctly states that Schulhuf teaches this step, citing 50 in Fig. 4; col. 4, lines 57-63; col. 7, lines 6-20; and col. 12, lines 54-63. Schulhuf's portable storage medium 50 stores programming segments at a client location that are transmitted at a high rate via a cable system 28 in Fig. 1. Here the similarity between the claimed subject matter and Schulhuf's system ends.

Claim 1, step 2: Claim 1 next requires the presence of the step of "*employing processing means to derive identification data from each of said first set of separate programming segments.*" In applicants' system, the identification data derived from the first set of programming segments may consist of short "snippets" extracted from the segments [Fig. 5 at 108].

The Examiner incorrectly states that Schulhuf teaches this step at col. 4, lines 63-64 and at col. 5, lines 5-8. Both of these cited passages describe Schulhuf's method for using the cable system 28 to display a menu of program segments that are stored on the remote server and available on request for transfer to and storage in the local store 50. There is no suggestion in either cited passage that identification data is derived from the first set of program segments stored in local storage as claimed. As the cited passage at col. 5, lines 5-8, makes clear, the catalog menu (identification data) that is displayed to user is obtained from a cable channel and not derived from programming segments stored at the client location as claimed.

Further, at page 8, the Examiner asserts that "Schulhuf clearly discloses at client location, employing processing means to derive identification data (i.e. particular program, identity of

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recorded material * * * from each of said first set of separate programming segments (i.e. user selects identification data already stored at client location; col. 4, lines 63-64)," newly citing col. 10, lines 52-55. But the additional passage likewise does not disclose or suggest that the catalog menu display from channel 66 (see col. 5, lines 5-9) is derived from the locally stored first set of programming segments.

Claim 1, step 3: Claim 1 further recites the step of *"transmitting said identification data from said client location to a remote processing location."* As shown by the arrow from 108 to 111, applicants' system transmits the snippets (identification data derived from the first set of programming segments in step 2 above) to the remote server.

The Examiner incorrectly states that Schulhuf describes this step in col. 5, lines 9-12 and 52-53; in col. 6, lines 31-39; and in col. 9, line 65 to col. 10, line 4. In the cited passages, Schulhuf describes how the user sends a menu selection to the remote server to specify one or more available program segments to be downloaded from the remote program library. These menu selections sent to the remote server are not derived from the locally stored program segments as noted above with respect to step 2.

Claim 1, step 4: Claim 1 next requires the presence of the step performed *"at said remote processing location, [of] comparing said identification data with a database containing identification information and associated content descriptions for each of a second set of programming segments to identify common program segments found in both said first and said second set of programming segments"* In applicants' system, the snippets derived from first set of program segments stored at the client location are received at the remote server and then supplied to a recognition engine (Fig. 5 at 111) which compares each snippet with a database 113 containing identification information (a signature database) and content descriptions (song specifications). See Fig. 5 ant 113 and Pg. 23, lines 10-12.

The Examiner cites the passage at col. 10, line 35 through col. 11, line 15, which describes the manner in which Schulhuf's system processes incoming catalog menu selections made by the subscriber. As noted above, however, these menu selections are not derived from the program segments recorded at the client location but are instead derived from a catalog menu sent from the remote location Moreover, no comparison is made at Schulhuf's server to identify common program segments found at both locations as required by step 4. In Section 7 of the

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final rejection, discussed below, the Examiner concedes that *"Schulhuf does not specifically disclose common program segments found in both said first and said second set of programming segments"* but contends that this difference would have been obvious in view of Ostrover. That contention is addressed below in the discussion of Ground 2.

Claim 1, step 5: Claim 1 next requires the presence of the step of *"transmitting from said remote processing location to said client location selected ones of content descriptions stored in said database which describe said common program segments."* In applicants' system as disclosed, when the recognition engine 111 is able to identify individual common programming segments found in both the first and second sets, it returns content descriptions for those segments to the client.

The Examiner cites the passages in Schulhuf at col. 6, lines 40-61 and at col. 10, lines 40-41. Both of these passages describe the manner in which program material that the subscriber has requested is transmitted from the remote program library to the subscriber to fulfill the subscriber's catalog selection request. There is no suggestion in either of these cited passages that content <u>descriptions</u> stored in a database are sent as required by claim 1, or that anything other than "actual program material" is sent. It should be noted that claim 1, step 5 also specifically requires the transmission of descriptions which describe the common program segments identified in step 4.

Schulhuf's system and applicants' system thus work in fundamentally different ways. In applicants' system, the client has already stored the program segments (steps 1 and 2 as claimed), and requires descriptions of these segments, not the program segments themselves (which the client has already stored). In Schulhuf's system, the client is first sent content descriptions in the form of a displayed catalog menu, and the client then requests and receives the program selections he or she wants but doesn't already have.

Claim 1, step 6: Lastly, claim 1 requires the presence of the step performed *"at said client location"* of *"presenting said selected content descriptions to a user to facilitate the selective processing of said common program segments."* In applicant's system, the content descriptions which are transmitted to the client from the server may be used to provide a program guide that displays songs by title, performer, album title, date, etc. to facilitate the selection,

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playback, archiving and erasure of program segments already stored in the local store and identified by the remote recognition engine from the uploaded snippets. See col. 7, lines 17-23.

The Examiner cites the passage in Schulhuf at col. 12, lines 18 to 26 which merely states that the subscriber can play back program segments downloaded from the remote library. The cited passages do not suggest that program selections transmitted to the subscriber are used to permit selective processing of common program segments found at both locations as claimed.

For the reasons presented above, applicants submit that Schulhuf does not disclose the anything that performs the functions recited in steps 2 through 6, even if the limitations regarding "common program segments" are ignored. Thus, even if the Schulhuf system were modified using the teachings of Ostrover as the Examiner has proposed and as discussed in more detail below, the resulting system would still differ in several important ways from the invention set forth in claim 1 as described above.

Ground 1, Claim 13

The Examiner did not address the specific limitations found in independent claim 13 which, it is submitted, differ in significant ways from the limitations of claim 1. To the extent claim 13 recites subject matter that corresponds to the subject matter set forth in claim 1, it is believed to be allowable for the reasons presented above with respect to claim 1. Moreover, the rejection of claim 13 is also believed to be erroneous for the additional reasons set forth below

Claim 13, preamble: Independent claim 13 defines *"A method for selectively reproducing previously broadcast programming segments."* Applicants disclose an arrangement for receiving, recording and then playing back previously broadcast programming segments. Schulhuf's system selectively reproduces program segments, but these segments are not "broadcast" in the usual sense of being sent simultaneously to multiple recipients, but are instead downloaded to only the specific subscriber that requested the specific program segments from the displayed catalog menu.

Claim 13, step 1: Claim 13 requires the presence of the step of *"employing a first broadcast receiver at a client location for capturing a broadcast signal."* In applicants' system, a broadcast receiver (Figs. 5 and 6 at 103) captures a broadcast signal using the antenna 105. As noted above, Schulhuf does not receive and store "broadcast" program signals but rather

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transmits specific program files to a specific subscriber in response to a request from that subscriber.

Claim 13, step 2: Claim 13 next requires the presence of the step of *"recording said broadcast signal in a local storage unit in a substantially continuous manner as said signal is received at said client location;* Applicants describe a recorder that consists of a broadcast receiver 103 coupled to an antenna 105. The incoming broadcast is recorded in a substantially continuous manner. See *Pg. 23, line 5-7 and 22-28 and Figs. 5 and 6 at 107.*

Schulhuf's program storage unit does not continuously record a broadcast signal as it is received by instead obtains program files transmitted in a high speed data transfer. See col. 5, lines 9-20.

Claim 13, step 3: Claim 13 further requires the presence of the step of *"processing said broadcast signal at said client location to extract brief segments from the content of said broadcast signal."* Applicant's system extracts brief segments ("snippets") from the content of the stored program signal. See *Pg. 23, lines 7-9; Fig. 5 at 109]*

Schulhuf nowhere suggests extracting brief segments of the content of any program data at any time, let alone extracting brief segments from the content of a continuously recorded broadcast signal as claimed.

Claim 13, step 4: Claim 13 also requires the presence of the step of *"utilizing a communications channel to transmit said brief segments from said client location to a remote processing location."* Applicants system transmits the extracted snippets to the remote location for processing. See, for example, Pg. 23, lines 7-9; Pg. 24, lines 12-27 and Figs. 5 and 6, arrow from 109 to 111].

Schulhuf's system does not extract or transmit brief segments as claimed.

Claim 13, step 5: Claim 13 further requires the presence of the step of *"comparing said segments received from said client location with a library of previously recorded programs to identify particular programs which contain segments matching the segments received from said client location."* At the remote server location, applicants' system employs the recognition engine seen at 111 in Figs. 5 and 6 to compare the received snippets with a library of previously

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recorded programs to identify programs containing matching segments   See Pg. 23, lines 10-18; pg. 24, lines 1-27; Fig. 5 at 111 and 113.

Schulhuf does not extract or send brief segments to the remote location and does not compare anything with a program library to identify particular programs which contain matching segments as claimed.

Claim 13, step 6: Lastly, claim 13 next requires the presence of the step of *"transmitting program guide data describing said particular programs to said client location from said remote programming location."* In applicant's system, program guide data is transmitted to the client from the server. See col. 7, lines 17-23.

Schulhuf does not use steps 2-5 to identify particular programs which contain matching segments and does not send program guide data describing such programs to the client.

Ground 1. Conclusion. Contrary to the Examiner's assertion, the cited Schulhuf patent fails to describe or suggest anything equivalent to those portions of applicants disclosed system that perform the method steps recited in independent claims 1 and 13. Even if the Schulhuf system was modified to incorporate the teaching of Ostrover as the Examiner has proposed, that would not cure the deficiencies of the Schulhuf teaching which fails to disclose the performance of the method steps discussed above.

The rejections of claims 1-10 and 13-20 based on Ground 1 should accordingly be reversed.

Ground 2: Claims 1 and 13.

The Examiner contends in Section 7, at page 3-4, of the final rejection that Ostrover discloses common program segments found in both said first and said second set of program segments, and that it would have been obvious to one of ordinary skill in the art to modify Schulhuf so that it too stored a mirrored copy of its data as taught by Ostrover.

The Examiner concedes that *"Schulhuf does not specifically disclose common program segments found in both said first and said second set of programming segments;"* however, the Examiner states that:

> *"Ostrover discloses common program segments found in both said first and said second set of programming segments (col. 14, lines 35-54; col. 20, lines*

44-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schulhuf and Ostrover because common program segments in Ostrover's would improve the mirroring contents of Schulhuf's system by allowing users to redundantly record the common programs, thereby allowing seamless play to take place (Ostrover, col. 20, lines 44-47)."

The Ostrover patent describes a method for recording more than one version of a program on an optical disk. For example, both the R-rated and G-rated versions of a motion picture may be recorded on a single disk. To conserve space, the common material is recorded in one place and the two different versions in two other places on the single disk. A playback mechanism is then used to combine the common version with a selected version to provide a continuous rendition of the selected version. However, to make sure that the playback is continuous, some of the common material is reproduced in both versions to make sure it's available when needed during reproduction. It is this dual recording of the common program material that the Examiner relies upon in his zeal to find a teaching of "common program material" being recorded in two places.

The Examiner thus is understood to contend that one of ordinary skill might modify Schulhuf's system so that it too stores multiple-version programs as described by Ostrover. However, it that was done, the resulting modification would not yield the "common program segments" which have the characteristics applicants have claimed.

In applicants' system, the recognition engine 111 attempts to identify matches between program segments at the client location and programs contained or identified in the server's database. Thus, the "common program segments" as claimed are programs that are already stored at the client location and also stored or identified in the server database. Applicants' claimed method extracts identification data from the client copy of programs, send this identification data to the remote server, and the server compares the received identification data with its stored program database to find common programs. To the extent it can find matches, the server then sends program content descriptions back to the client for the common programs, thereby providing a program guide the client can use to navigate and playback the identified common programs previously recorded at the client.

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If the modification proposed by the Examiner were made, some of the programs stored in the Schulhuf program library might be multiple version programs which, as stored in the library, might include disk copies which contain some duplicate common content, enabling a particular requested version to be seamlessly reproduced as taught by Ostrover. But that would not yield a system in which identification data from a client copy of the common program is extracted, sent to the server, compared with the other copy at the server, and result in the transmission of content descriptions for that common program back to the client for use as program guide. If the teaching of Ostrover was combined with the teaching of Schulhuf, the only duplicate common program material would still reside on single program disks at the server and nowhere else.

Ground 2. Conclusion. Thus, the proposed combination of Schulhuf and Ostrover proposed by the Examiner would not yield the combination of steps claimed in independent claims 1 and 13. The rejection of claims 1-10 and 13-20 as being directed to obvious subject matter should accordingly be reversed.

Ground 3: Claim 5. Claim 5 states that the identification information contained in the database at the remote processing location is *"derived from said broadcasted programming signals received at said remote processing location concurrently with the reception and recording of said broadcast programming signals at said client location."* Applicants system may be used to concurrently record a given broadcast at both the client location and at the remote location, in which case the broadcast signal received at the remote server location is "marked up" to identify particular programs and to associate content descriptions with those programs. After the database at the server location is built, the identification data from the client location is processed to identify matching common segments.

In rejecting claim 5, the Examiner stated only that Schulhuf discloses identification data in a database derived from programming signals, and cites col. 9, line 64 to col. 10, line 14 of Schulhuf which describes the manner in which Schulhuf displays a catalog of program descriptions to the subscriber from which the subscriber may request desired programs. There is nothing in the cited passages that suggests that the programs which are available at the server were concurrently recorded at the client, and indeed Schulhuf "teaches away" from such a

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possibility since the subscriber would have no reason to display listings of and request the download of programs that have already been recorded at the client location.

Claim 5 goes on to recite that the content descriptions that are contained in the database at the remote server and that are transmitted to said client location *"are used at said client location to facilitate the selective time-shifted reproduction of said broadcast programming signals."* In applicants' system, the program segments in the broadcast programming can be "time-shifted;" that is, played back at a later time after the original broadcast was recorded. The downloaded content descriptions from the remote server which describe these locally stored programs are used as a program guide to facilitate the later navigation and playback of these previously recorded broadcasts in a time-shifted manner. See *Pg. 4, lines 1-2; Pg. 22, lines 26-29; Pg. 23, lines 18-21,*

Schulhuf describes nothing of the sort. Schulhuf's client does not continuously record broadcast programs and then later selectively play them back time-shifted from the time of the original broadcast using program guide content descriptions downloaded from a server.

The rejection of claim 5 should be reversed for the reasons given above with respect to its parent claim 1 and for the addition reason that claim 5 plainly recites additional subject matter neither disclosed nor suggested by the cited art.

Ground 4, Claims 6 and 15. Claims 6 and 15 state that said content descriptions transmitted from the remote processing location to said client location include information specifying the beginning and ending time of each of said common program segments. In applicants system, in order to identify individual program segments within the recorded broadcast programming material in the client's local storage, the content descriptions from the server may identify those programs by specifying the beginning and ending time of each segment (typically specified relative to the "snippet" that was identified). See *Pg. 15, lines 1-9; Pg. 22, lines 17-30.*

The Examiner's rejection of claims 6 and 15 is based on a passage at col. 6, lines 19-23 which states that the server library may provide *"daily delivery of a morning newspaper in audio format that allows a subscriber to listen to the news in a way that the news is not interrupted by commercial breaks and not truncated to fit into a tight broadcast schedule."* This passage says

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nothing about specifying the beginning and ending times of common program segments already recorded at the client.

The rejection of claims 5 and 6 should be reversed for the reasons given above with respect to their parent claims 1 and 13 respectively, and for the addition reason that these claims recites additional subject matter neither disclosed or suggested by the cited art.

Ground 5, Claims 7 and 9. Claims 7 and 9 are similar and further recite *"the steps of uploading a copy of a program segment stored locally at said client location to said remote processing location and storing the uploaded copy in said stored library for later retrieval from said remote processing location."* In applicants' system, the client may upload a copy of one or more of the program segments identified on the local store to the remote server to allow the user to free space on the local store, or to access the program segments from other players.

The Examiner cites no specific teaching in Schulhuf in rejecting claim 7, and states only that it is rejected "for the same reasons set forth in claim 1." In rejecting claim 9, the Examiner cited col. 5, lines 9-12 and 52-53; col. 6, lines 31-39 and col. 9, line 65 to col. 10, line 4. These cited passages describe the manner in which the client sends program selection requests to the remote location, but nowhere suggest *uploading locally stored program segments.*

The rejection of claims 7 and 9 should be reversed for the reasons given above with respect to their parent claim 1, and for the addition reason that these claims recite additional subject matter neither disclosed nor suggested by the cited art.

Ground 6, Claim 10. Claim 10 sets forth the additional steps of "posting an entry in an accounting file upon the transmittal of said identification data to said remote processing location, subsequently transmitting a playback request identifying said client location and identifying a requested program segment, and authorizing the transmittal of said requested program segment if said accounting file contains data indicating that identification data for said requested program segment was previously transmitted from said client location." In the embodiment of applicants' system shown in Fig. 6 and described at Pg. 25, lines 17-29, if the applicant uploads identification data that demonstrates that a copy of a common program segment has already been recorded on the client's local store, the remote server will send the client a copy (perhaps to a different player) if the accounting file indicates that the client has demonstrated prior ownership of the common segment.

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The Examiner contends that Schulhuf discloses these steps at col. 10, lines 52-65. However, the cited passages merely describe the manner in which requests from multiple subscribers for a single program segment in the library are grouped for more efficient transmission. The cited passage does not describe the claimed steps transmitting a given program segment to a client if and only if the client first demonstrates that a copy was previously stored at the client location by transmitting identification data for that segment.

The rejection of claim 10 should be reversed for the reasons given above with respect to its parent claim 1, and for the addition reason that claim 10 recites additional subject matter neither disclosed or suggested by the cited passage of Schulhuf relied upon by the Examiner.

Ground 7, Claims 14 and 18. Claims 14 and 18 are similar and both are dependent on claim 13. Claim 14 further requires the presence of the steps of *"displaying said program guide data for use at said client station to facilitate the selection and reproduction of desired ones of said particular programs."* As previously discussed in connection with claim 1, step 6, in applicant's system, the program guide sent to the client can, for example, display songs by title, performer, album title, date, etc. to facilitate the selection, playback, archiving and erasure of program segments already stored in the local store and identified by the remote recognition engine from the uploaded snippets. See col. 7, lines 17-23.

The Examiner contends in Section 16 at page 5 of the final rejection that the subject matter recited in dependent claims 14 and 18 is disclosed by Schulhuf at col. 5, lines 5-8 which describes how a menu of catalog selections is displayed from television cable channel 66. These menu selections are not, however, program guide data of the kind recited in claim 13, as explained above in connection with Ground 1, claim 13, step 6.

The rejection of claims 14 and 18 should be reversed for the reasons given above with respect to its parent claim 13, and for the addition reason that claims 14 and 16 recite additional subject matter neither disclosed nor suggested by the cited passage of Schulhuf relied upon by the Examiner.
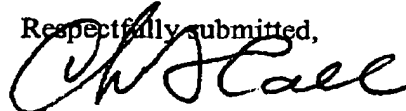
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Conclusion

The rejection of claims 1-10 and 13-20 for obviousness in view of Schulhuf and Ostrover should be reversed.

Claims appendix.

An appendix containing a copy of the claims involved in the appeal is attached.

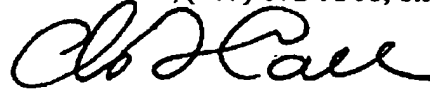Respectfully submitted,

Dated: December 22, 2004

Charles G. Call, Reg. 20,406

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I hereby certify that this *Appellants' Brief* is being transmitted by facsimile to the central facsimile number of the U.S. Patent and Trademark Office, (703) 872-9306, on December 23, 2004.

Dated: December 22, 2004   Signature

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